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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/709,143	11/10/2000	William C. Tate	81803F-P	3253

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EXAMINER	
THEIN, MARIA TERESA T	

ART UNIT	PAPER NUMBER
3627	

DATE MAILED: 03/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/709,143	TATE, WILLIAM C.	
	Examiner	Art Unit	
	Marissa Thein	3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 December 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-36* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-36* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *17 December 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 17, 2004 has been entered.

Drawings

The drawings filed on December 17, 2004 are acceptable.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-9, 12-22 and 25-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,549,612 to Gifford in view of U.S. Patent No. 6,321,231 to Jebens et al.

Regarding claims 1-2 and 27, Gifford discloses a method and a computer software product for ordering goods and/or services (e-mail notification includes not only information on what triggered the email, it also includes the online interface that links to a web brokerage application. That application then allows the client (customer) to buy

or sell stocks/option (goods and/or services), col. 4, lines 50-54) over a communication network (digital communication network, col. 3, lines 14-15; local or wide-are network, col. 1, lines 18-19): providing a server (Unified communications server (UC server), col. 4, lines 31-33) of a first party for sending e-mail to a receiving site of a customer (UC server sends an e-mail to a subscriber, col. 6., lines 25-26) over said communication network, the e-mail having a static section for containing static text (subscriber's message, col. 7, lines 11-13; Figure 2) and/or graphics and a dynamic area/section for containing dynamic data (Enriched E-mail has sections which contain dynamic information which are always current even if the actual e-mail message is old, col. 7, lines 46-48; Ref. no. 203, Figure 2), the dynamic data is automatically forwarded by said server to said receiving site only upon opening the e-mail at the receiving site (since the dynamic information is kept on the UC server until the e-mail HTML interface requests it in response to a subscriber opening the e-mail, col. 7, lines 51-54; After opening the mail,.....the interaction controls also can load information dynamically and automatically into the document once the e-mail is opened, e.g. without requiring explicit user action after opening the e-mail, col. 7, lines 11-19).

However, Gifford does not explicitly disclose digital data files containing digital images and low-resolution digital image file **(claim 2)**. Gifford discloses a messaging system which receives messages and provides access to those message in digital form across the digital communication network (col. 3, lines 16-19). Furthermore, Gifford discloses non-liter message means a message that is not text-only or a message that needs to be rendered such as an image (col. 6, lines 16-19).

Jebens, on the other hand, teaches the digital data being digital images (digital image, col. 2, lines 64-65); and low-resolution digital image file (**Claim 2)** (low-resolution copy of each of a plurality of digital images, col. 2, lines 66-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Gifford, to include the digital images and low-resolution digital image file, as taught by Jebens, so as to provide an intelligent order delivery system which achieves an automatic, integrated workflow for transferring digital assets between users (Jebens, col. 24, lines 2-4).

Regarding claims 3, 5-9 (depend on claim 1), 16, 18-22 (depend on claim 14), Gifford substantially discloses the claimed invention, however, Gifford does not disclose an order form; URL address of a second party; the second party will fulfill the order placed by the customer; the portion of the money paid; and a notice is sent to the first party by the second party when the order is placed with the second party. Gifford disclose the notification email includes not only information on what triggered the email, it also includes the online interface that links to a web brokerage application (order). That application then allows the client (customer) to buy or sell the stock/option (goods and//or services). By using the interface, the client can also request other information, which can be displayed in a Java applet or as a dynamically generated HTML page. (Col. 4, lines 50-59) Furthermore, Gifford discloses an enriched email message is sent out to bill for service rendered which includes paying the bill electronically (col. 4, line 61 – col.5, line 15).

Jebens, on the other hand, teaches order form (New order, Ref. no. 820, Figure 10F; col. 21, lines 65-67); URL address of a second party (jobber/supplier 16) (col. 8, lines 23-25; col. 22, lines 47-50); second party (jobber/supplier 16) will fulfill the order placed by the customer (col. 22, lines 24-35); a notice is sent to the first party (host site 10) by the second party when the order is placed with the second party (col. 23, lines 3-8); a portion of the money paid by the customer to the second party is allocated to the first party (col. 17, lines 48- col. 18, line 5; col. 18, lines 14-18); and portion of the money paid to the second party is forwarded to the first party upon or after receipt of payment by the customer to the second party (col. 17, lines 48- col. 18, line 5; col. 18, lines 14-18).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Gifford, to include the order form, URL address of a second party; the second party will fulfill the order, a notice, and a portion of the money, as taught by Jebens, so as to provide an intelligent order delivery system which achieves an automatic, integrated workflow for transferring digital assets between users (Jebens, col. 24, lines 2-4).

Regarding claim 4 (depend on claim 1), 17 (depend on claim 14), Gifford substantially disclose the claimed invention, specifically the static text and/or graphic (subscriber's message, col. 7, lines 11-13; Figure 2; an e-mail notification, col. 16, lines 25-26) includes at least one location for receiving the image (an active interface embedded in an e-mail notification to control delivery of a non-literal, single media or multimedia message to the subscriber, abstract; non-literal message such as an image,

col. 6, lines 16-18; col. 16, lines 25-26) upon opening the email (col. 7, lines 11-18; col. 16, lines 27-32) (col. 7, lines 50-59).

However, Gifford does not explicitly disclose digital images. Gifford discloses a messaging system which receives messages and provides access to those message in digital form across the digital communication network (col. 3, lines 16-19). Furthermore, Gifford discloses non-liter message means a message that is not text-only or a message that needs to be rendered such as an image (col. 6, lines 16-19).

Jebens, on the other hand, teaches the digital images (digital image, col. 2, lines 64-65).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Gifford, to include the digital images, as taught by Jebens, so as to provide an intelligent order delivery system which achieves an automatic, integrated workflow for transferring digital assets between users (Jebens, col. 24, lines 2-4).

Regarding claims 12-13 (depend on claim 1), and 25-26 (depend on claim 14), Gifford discloses the server allows the third party to provide data to the dynamic data (the dynamic information is imported from a third party source, col. 8, lines 11-12); and Internet (Internet, col. 3, line 19-20).

Regarding claims 14-15 and 28, Gifford discloses a method and a computer software product for ordering goods and/or services (e-mail notification includes not only information on what triggered the email, it also includes the online interface that links to a web brokerage application. That application then allows the client (customer) to buy

or sell stocks/option (goods and/or services), col. 4, lines 50-54) over a communication network (digital communication network, col. 3, lines 14-15; local or wide-are network, col. 1, lines 18-19);\: providing a server (Unified communications server (UC server), col. 4, lines 31-33) of a first party for sending e-mail to a receiving site of a customer (UC server sends an e-mail to a subscriber, col. 6., lines 25-26) over said communication network, the e-mail having a static section for containing static text (subscriber's message, col. 7, lines 11-13; Figure 2) and/or graphics and a dynamic area/section for containing dynamic data (Enriched E-mail has sections which contain dynamic information which are always current even if the actual e-mail message is old, col. 7, lines 46-48; Ref. no. 203, Figure 2), the dynamic data is automatically forwarded by said server to said receiving site only upon opening the e-mail at the receiving site (since the dynamic information is kept on the UC server until the e-mail HTML interface requests it in response to a subscriber opening the e-mail, col. 7, lines 51-54; After opening the mail,.....the interaction controls also can load information dynamically and automatically into the document once the e-mail is opened, e.g. without requiring explicit user action after opening the e-mail, col. 7, lines 11-19).

However, Gifford does not explicitly disclose the static text and/or graphics contain an order section for ordering goods and/or services, digital data files containing digital images and low-resolution digital image file **(claim 15)**. Gifford disclose the notification email includes not only information on what triggered the email, it also includes the online interface that links to a web brokerage application (order). That application then allows the client (customer) to buy or sell the stock/option (goods

and//or services). By using the interface, the client can also request other information, which can be displayed in a Java applet or as a dynamically generated HTML page. (Col. 4, lines 50-59) Furthermore, Gifford discloses a messaging system which receives messages and provides access to those message in digital form across the digital communication network (col. 3, lines 16-19). Moreover, Gifford discloses non-liter message means a message that is not text-only or a message that needs to be rendered such as an image (col. 6, lines 16-19).

Jebens, on the other hand, teaches the static text and/or graphics contain an order section for ordering goods and/or services (custom e-mail form for "New Order" ref. no. 820, Figure 10F, col. 21, lines 63-67); the digital data being digital images (digital image, col. 2, lines 64-65); and low-resolution digital image file (**Claim 15)** (low-resolution copy of each of a plurality of digital images, col. 2, lines 66-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Gifford, to include the order section in the static text, the digital images and low-resolution digital image file, as taught by Jebens, so as to provide an intelligent order delivery system which achieves an automatic, integrated workflow for transferring digital assets between users (Jebens, col. 24, lines 2-4).

Regarding claims 29-30, Gifford discloses a system for ordering goods and/or services (e-mail notification includes not only information on what triggered the email, it also includes the online interface that links to a web brokerage application. That application then allows the client (customer) to buy or sell stocks/option (goods and/or

services), col. 4, lines 50-54) over a communication network (digital communication network, col. 3, lines 14-15; local or wide-are network, col. 1, lines 18-19): a retailer (brokerage company) for receiving a product from a customer for the providing of goods and/or service for the customer (e-mail notification includes not only information on what triggered the email, it also includes the online interface that links to a web brokerage application. That application then allows the client (customer) to buy or sell stocks/option (goods and/or services), col. 4, lines 50-54); a server (Unified communications server (UC server), col. 4, lines 31-33) of a first party for sending e-mail to a receiving site of a customer (UC server sends an e-mail to a subscriber, col. 6., lines 25-26) over said communication network, the e-mail having a static section for containing static text (subscriber's message, col. 7, lines 11-13; Figure 2) and/or graphics and a dynamic area/section for containing dynamic data (Enriched E-mail has sections which contain dynamic information which are always current even if the actual e-mail message is old, col. 7, lines 46-48; Ref. no. 203, Figure 2), the dynamic data is automatically forwarded by said server to said receiving site only upon opening the e-mail at the receiving site (since the dynamic information is kept on the UC server until the e-mail HTML interface requests it in response to a subscriber opening the e-mail, col. 7, lines 51-54; After opening the mail,.....the interaction controls also can load information dynamically and automatically into the document once the e-mail is opened, e.g. without requiring explicit user action after opening the e-mail, col. 7, lines 11-19).

However, Gifford does not explicitly disclose the static text and/or graphics contain an order section for ordering goods and/or services, a fulfillment provider, and

digital data files containing digital images. Gifford disclose the notification email includes not only information on what triggered the email, it also includes the online interface that links to a web brokerage application (order). That application then allows the client (customer) to buy or sell the stock/option (goods and//or services). By using the interface, the client can also request other information, which can be displayed in a Java applet or as a dynamically generated HTML page. (Col. 4, lines 50-59) Furthermore, Gifford discloses a messaging system which receives messages and provides access to those message in digital form across the digital communication network (col. 3, lines 16-19). Moreover, Gifford discloses non-liter message means a message that is not text-only or a message that needs to be rendered such as an image (col. 6, lines 16-19).

Jebens, on the other hand, teaches the static text and/or graphics contain an order section for ordering goods and/or services (custom e-mail form for "New Order" ref. no. 820, Figure 10F, col. 21, lines 63-67), a fulfillment provider (jobber/supplier 16) (col. 22, lines 24-35), and the digital data being digital images (digital image, col. 2, lines 64-65).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Gifford, to include the order section in the static text, a fulfillment provider, and the digital images, as taught by Jebens, so as to provide an intelligent order delivery system which achieves an automatic, integrated workflow for transferring digital assets between users (Jebens, col. 24, lines 2-4).

Regarding claim 31, Gifford discloses the server is remote from the retailer (wide area network; col. 1, lines 16-19).

Regarding claim 32-33, Gifford substantially disclose the claimed invention, however, it does not disclose the fulfillment provider is remote from the retailer and the server. Gifford does disclose a system for providing communication services over a local or wide area network (col. 1, lines 16-19).

Jebens, on the other hand, teaches the fulfillment provider is remote from the retailer and the server (col. 2, lines 38-40; col. 6, line 66 – col. 7, line 4).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Gifford, to include the fulfillment provider is remote from the retailer and the server, as taught by Jebens, in order to provide communication by the receiving and transmitting of data to one or more remote users (Jebens, col. 2, lines 38-40).

Regarding claim 34, Gifford substantially disclose the claimed invention, however, it does not disclose the fulfillment provider pays the retailer a portion of payment received from the customer for the order. Gifford discloses an enriched email message is sent out to bill for service rendered which includes paying the bill electronically (col. 4, line 61 – col.5, line 15).

Jebens, on the other hand, teaches the fulfillment provider pays the retailer a portion of payment received from the customer for the order (col. 17, lines 48- col. 18, line 5; col. 18, lines 14-18).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Gifford, to include the fulfillment provider pays the retailer a portion of payment received from the customer for the order, as taught by Jebens, in order to provide all the charges for a given user which are displayed in an invoice, wherein the invoices are routed to the appropriate users by the mail server (Jebens, col. 17, lines 49-55).

Regarding claims 35-36, Gifford substantially disclose the claimed invention, however, it does not disclose the fulfillment provider receives orders from a plurality of retailers, where means are provided for keeping track of which said plurality of retailers forwards which of the orders to the fulfillment provider and forwarding a portion of payment. Gifford discloses services which allow a user to be tracked (col. 3, lines 8-11). Gifford discloses an enriched email message is sent out to bill for service rendered which includes paying the bill electronically (col. 4, line 61 – col. 5, line 15).

Jebens, on the other hand, teaches he fulfillment provider receives orders from a plurality of retailers, where means are provided for keeping track of which said plurality of retailers forwards which of the orders to the fulfillment provider (event tracking means, col. 2, lines 35-38) and forwarding a portion of payment (col. 17, lines 48- col. 18, line 5; col. 18, lines 14-18).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Gifford, to include the fulfillment provider receives orders from a plurality of retailers, where means are provided for keeping track of which said plurality of retailers forwards which of the orders to the fulfillment provider

and forwarding a portion of payment, as taught by Jebens, in order to monitor and record events occurring in the system thus to provide a charge for at least the event recorded by the tracker (Jebens col. 2, lines 35-38). Thus, it would provide all the charges for a given user which are displayed in an invoice, wherein the invoices are routed to the appropriate users by the mail server (Jebens, col. 17, lines 49-55).

Claims 10-11 and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,549,612 to Gifford and U.S. Patent No. 6,321,231 to Jebens et al as applied to claims 1 and 14 above, and further in view of U.S. Patent No. 6,657,702 to Chui et al. Gifford and Jebens substantially discloses the claimed invention, specifically, the email includes the ability for the customer to send an e-mail to a third party for allowing access to the images (Gifford, forwarding the received message to one or more parties, col. 6, lines 6-7). However, the combination does not explicitly disclose placement of an order and the customer permits the third party to provide additional data to the images.

Chui, on the other hand, teaches the placement of an order (Figure 9; col. 21, lines 31-51) and the customer permits the third party to provide additional data to the images (col. 6, lines 34-42).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the combination of Gifford and Jebens, to include the placement of an order and the customer permits the third party to provide additional data to the images, as taught by Chui, in order for the user (customer) to distribute copies of prints (digital image) to recipients (third party) more quickly and with less

expense and effort (Chui, col. 8, lines 54-61), thus providing increase efficiency and/or speed of the print generation and distribution task dramatically (Chui, col. 9, lines 5-6).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 6,449,635 to Tilden, Jr. et al. discloses an electronic mail deployment system which delivers large quantities of information into a short e-mail message automatically upon opening of the email by a user.

U.S> Patent No. 6,009,462 to Birrell et al. discloses a method for down-loading mail messages, where the mail message comprises a primary component encoded in a first format and at least one secondary component encoded in a second format different from the first component. The secondary component is replaced with a hot-link.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa Thein whose telephone number is 703-305-5246. The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on 703-308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mtot
March 6, 2005

James S. McClellan
JAMES MCCLELLAN
PRIMARY EXAMINER
3/6/05